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10 Attorneys for Plaintiff and Counterdefendant
MAXIM INTEGRATED PRODUCTS, INC.

11
12 UNITED STATES DISTRICT COURT
13 NORTHERN DISTRICT OF CALIFORNIA
14 SAN FRANCISCO DIVISION
15

16 MAXIM INTEGRATED PRODUCTS, INC.,

17 Plaintiff,

18 v.

19 FREESCALE SEMICONDUCTOR, INC.,

20 Defendant.
21

22 FREESCALE SEMICONDUCTOR, INC.,

23 Counterclaimant,

24 v.
25

26 MAXIM INTEGRATED PRODUCTS, INC.,

27 Counterdefendant.
28

Case No. CV 08-00979-MHP

**PLAINTIFF MAXIM INTEGRATED
PRODUCTS, INC.'S REPLY TO
DEFENDANT FREESCALE
SEMICONDUCTOR, INC.'S
COUNTERCLAIMS**

1 Plaintiff and Counterdefendant Maxim Integrated Products, Inc. (“Maxim”) hereby
2 replies to the Claims set forth in Defendant and Counterclaimant Freescale Semiconductor,
3 Inc.’s (“Freescale”) Counterclaims and Demand for Jury Trial as follows:

4 **PARTIES**

5 1. Maxim admits the allegations of paragraph 30 of Freescale’s Counterclaims.

6 2. Maxim is without knowledge or information sufficient to form a belief as to
7 the truth of the allegations of paragraph 31 of Freescale’s Counterclaims, and on that basis,
8 denies them.

9 **JURISDICTION AND VENUE**

10 3. Maxim admits the allegations of paragraph 32 of Freescale’s Counterclaims.

11 4. Maxim admits the allegations of paragraph 33 of Freescale’s Counterclaims.

12 5. Maxim admits that it manufactures and sells various semiconductor devices or
13 integrated circuits in California and the Northern District of California, and except as
14 expressly admitted, Maxim denies the allegations of paragraph 34 of Freescale’s
15 Counterclaims.

16 6. Maxim admits the allegations of paragraph 35 of Freescale’s Counterclaims.

17 **GENERAL ALLEGATIONS**

18 7. Maxim admits that U.S. Patent No. 5,089,722 (“the ‘722 patent”), attached as
19 Exhibit A, bears the title “High speed output buffer circuit with overlap current control” and
20 an issue date of February 18, 1992. Except as expressly admitted, Maxim denies the
21 allegations of paragraph 36 of Freescale’s Counterclaims.

22 8. Maxim admits that U.S. Patent No. 5,105,250 (“the ‘250 patent”), attached as
23 Exhibit B, bears the title “Heterojunction bipolar transistor with a thin silicon emitter” and
24 an issue date of April 14, 1992. Except as expressly admitted, Maxim denies the allegations
25 of paragraph 37 of Freescale’s Counterclaims.

26 9. Maxim admits that U.S. Patent No. 5,172,214 (“the ‘214 patent”), attached as
27 Exhibit C, bears the title “Leadless semiconductor device and method for making the same”
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1 and an issue date of December 15, 1992. Except as expressly admitted, Maxim denies the
2 allegations of paragraph 38 of Freescale's Counterclaims.

3 10. Maxim admits that U.S. Patent No. 5,200,362 ("the '362 patent"), attached as
4 Exhibit D, bears the title "Method of attaching conductive traces to an encapsulated
5 semiconductor die using a removable transfer film" and an issue date of April 6, 1993.
6 Except as expressly admitted, Maxim denies the allegations of paragraph 39 of Freescale's
7 Counterclaims.

8 11. Maxim admits that U.S. Patent No. 5,434,739 ("the '739 patent"), attached as
9 Exhibit E, bears the title "Reverse battery protection circuit" and an issue date of July 18,
10 1995. Except as expressly admitted, Maxim denies the allegations of paragraph 40 of
11 Freescale's Counterclaims.

12 12. Maxim admits that U.S. Patent No. 5,776,798 ("the '798 patent"), attached as
13 Exhibit F, bears the title "Semiconductor package and method thereof" and an issue date of
14 July 7, 1998. Except as expressly admitted, Maxim denies the allegations of paragraph 41
15 of Freescale's Counterclaims.

16 13. Maxim admits that Freescale purports to allege that Maxim infringes U.S.
17 Patent Nos. 5,089,722; 5,105,250; 5,172,214; 5,200,362; 5,434,739; and 5,776,798
18 (collectively "the Counterclaim Freescale Patents"). Except as expressly admitted, Maxim
19 denies the allegations of paragraph 42 of Freescale's Counterclaims.

20 **FIRST CLAIM FOR RELIEF**

21 **Infringement of the '722 Patent**

22 14. Except as expressly admitted, Maxim denies the allegations of Paragraphs 30
23 to 42 of Freescale's Counterclaims.

24 15. Maxim admits that Freescale purports to allege that Maxim infringes,
25 contributes to the infringement of, and/or induces infringement of the '722 patent. Except
26 as expressly admitted, Maxim denies the allegations of paragraph 44 of Freescale's
27 Counterclaims.

28 16. Maxim admits that Freescale provided a book of patent claim charts to

1 Maxim, including charts on the '722 patent. Except as expressly admitted, Maxim denies
2 the allegations of paragraph 45 of Freescale's Counterclaims.

3 17. Maxim admits that Freescale provided a book of patent claim charts to
4 Maxim, including charts on the '722 patent. Except as expressly admitted, Maxim denies
5 the allegations of paragraph 46 of Freescale's Counterclaims.

6 18. Maxim denies the allegations of paragraph 47 of Freescale's Counterclaims.

7 **SECOND CLAIM FOR RELIEF**

8 **Infringement of the '250 Patent**

9 19. Except as expressly admitted, Maxim denies the allegations of Paragraphs 30
10 to 47 of Freescale's Counterclaims.

11 20. Maxim admits that Freescale purports to allege that Maxim infringes,
12 contributes to the infringement of, and/or induces infringement of the '250 patent. Except
13 as expressly admitted, Maxim denies the allegations of paragraph 49 of Freescale's
14 Counterclaims.

15 21. Maxim admits that Freescale provided a book of patent claim charts to
16 Maxim, including charts on the '250 patent. Except as expressly admitted, Maxim denies
17 the allegations of paragraph 50 of Freescale's Counterclaims.

18 22. Maxim admits that Freescale provided a book of patent claim charts to
19 Maxim, including charts on the '250 patent. Except as expressly admitted, Maxim denies
20 the allegations of paragraph 51 of Freescale's Counterclaims.

21 23. Maxim denies the allegations of paragraph 52 of Freescale's Counterclaims.

22 **THIRD CLAIM FOR RELIEF**

23 **Infringement of the '214 Patent**

24 24. Except as expressly admitted, Maxim denies the allegations of Paragraphs 30
25 to 52 of Freescale's Counterclaims.

26 25. Maxim admits that Freescale purports to allege that Maxim infringes,
27 contributes to the infringement of, and/or induces infringement of the '214 patent. Except
28 as expressly admitted, Maxim denies the allegations of paragraph 54 of Freescale's

1 Counterclaims.

2 26. Maxim admits that Freescale provided patent claim charts to Maxim,
3 including charts on the '214 patent. Except as expressly admitted, Maxim denies the
4 allegations of paragraph 55 of Freescale's Counterclaims.

5 27. Maxim admits that Freescale provided patent claim charts to Maxim,
6 including charts on the '214 patent. Except as expressly admitted, Maxim denies the
7 allegations of paragraph 56 of Freescale's Counterclaims.

8 28. Maxim denies the allegations of paragraph 57 of Freescale's Counterclaims.

9 **FOURTH CLAIM FOR RELIEF**

10 **Infringement of the '362 Patent**

11 29. Except as expressly admitted, Maxim denies the allegations of Paragraphs 30
12 to 57 of Freescale's Counterclaims.

13 30. Maxim admits that Freescale purports to allege that Maxim infringes,
14 contributes to the infringement of, and/or induces infringement of the '362 patent. Except
15 as expressly admitted, Maxim denies the allegations of paragraph 59 of Freescale's
16 Counterclaims.

17 31. Maxim admits that Freescale provided patent claim charts to Maxim,
18 including charts on the '362 patent. Except as expressly admitted, Maxim denies the
19 allegations of paragraph 60 of Freescale's Counterclaims.

20 32. Maxim admits that Freescale provided patent claim charts to Maxim,
21 including charts on the '362 patent. Except as expressly admitted, Maxim denies the
22 allegations of paragraph 61 of Freescale's Counterclaims.

23 33. Maxim denies the allegations of paragraph 62 of Freescale's Counterclaims.

24 **FIFTH CLAIM FOR RELIEF**

25 **Infringement of the '739 Patent**

26 34. Except as expressly admitted, Maxim denies the allegations of Paragraphs 30
27 to 62 of Freescale's Counterclaims.

28 35. Maxim admits that Freescale purports to allege that Maxim infringes,

1 contributes to the infringement of, and/or induces infringement of the '739 patent. Except
2 as expressly admitted, Maxim denies the allegations of paragraph 64 of Freescale's
3 Counterclaims.

4 36. Maxim admits that Freescale provided a book of patent claim charts to
5 Maxim, including charts on the '739 patent. Except as expressly admitted, Maxim denies
6 the allegations of paragraph 65 of Freescale's Counterclaims.

7 37. Maxim admits that Freescale provided a book of patent claim charts to
8 Maxim, including the '739 patent. Except as expressly admitted, Maxim denies the
9 allegations of paragraph 66 of Freescale's Counterclaims.

10 38. Maxim denies the allegations of paragraph 67 of Freescale's Counterclaims.

11 **SIXTH CLAIM FOR RELIEF**

12 **Infringement of the '798 Patent**

13 39. Except as expressly admitted, Maxim denies the allegations of Paragraphs 30
14 to 67 of Freescale's Counterclaims.

15 40. Maxim admits that Freescale purports to allege that Maxim infringes,
16 contributes to the infringement of, and/or induces infringement of the '798 patent. Except
17 as expressly admitted, Maxim denies the allegations of paragraph 69 of Freescale's
18 Counterclaims.

19 41. Maxim admits that Freescale provided a book of patent claim charts to
20 Maxim, including the '798 patent. Except as expressly admitted, Maxim denies the
21 allegations of paragraph 70 of Freescale's Counterclaims.

22 42. Maxim admits that Freescale provided a book of patent claim charts to
23 Maxim, including the '798 patent. Except as expressly admitted, Maxim denies the
24 allegations of paragraph 71 of Freescale's Counterclaims.

25 43. Maxim denies the allegations of paragraph 72 of Freescale's Counterclaims.
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AFFIRMATIVE DEFENSES

44. By alleging the matters set forth below as affirmative defenses, Maxim does not thereby allege or admit that Maxim has the burden of proof with respect to any of said matters.

FIRST AFFIRMATIVE DEFENSE**Non-Infringement and/or Invalidity of the '722 Patent**

45. Maxim's accused products and/or processes have not and do not infringe, contribute to the infringement of, and/or induce the infringement of any asserted claim of the '722 patent and/or each asserted claim of the '722 patent is invalid for failure to meet one or more of the statutory and decisional requirements for patentability, including, but not limited to, 35 U.S.C. §§ 101-103 and/or 112.

SECOND AFFIRMATIVE DEFENSE**Non-Infringement and/or Invalidity of the '250 Patent**

46. Maxim's accused products and/or processes have not and do not infringe, contribute to the infringement of, and/or induce the infringement of any asserted claim of the '250 patent and/or each asserted claim of the '250 patent is invalid for failure to meet one or more of the statutory and decisional requirements for patentability, including, but not limited to, 35 U.S.C. §§ 101-103 and/or 112.

THIRD AFFIRMATIVE DEFENSE**Non-Infringement and/or Invalidity of the '214 Patent**

47. Maxim's accused products and/or processes have not and do not infringe, contribute to the infringement of, and/or induce the infringement of any asserted claim of the '214 patent and/or each asserted claim of the '214 patent is invalid for failure to meet one or more of the statutory and decisional requirements for patentability, including, but not limited to, 35 U.S.C. §§ 101-103 and/or 112.

FOURTH AFFIRMATIVE DEFENSE**Non-Infringement and/or Invalidity of the '362 Patent**

48. Maxim's accused products and/or processes have not and do not infringe, contribute to the infringement of, and/or induce the infringement of any asserted claim of the '362 patent and/or each asserted claim of the '362 patent is invalid for failure to meet one or more of the statutory and decisional requirements for patentability, including, but not limited to, 35 U.S.C. §§ 101-103 and/or 112.

FIFTH AFFIRMATIVE DEFENSE**Non-Infringement and/or Invalidity of the '739 Patent**

49. Maxim's accused products and/or processes have not and do not infringe, contribute to the infringement of, and/or induce the infringement of any asserted claim of the '739 patent and/or each asserted claim of the '739 patent is invalid for failure to meet one or more of the statutory and decisional requirements for patentability, including, but not limited to, 35 U.S.C. §§ 101-103 and/or 112.

SIXTH AFFIRMATIVE DEFENSE**Non-Infringement and/or Invalidity of the '798 Patent**

50. Maxim's accused products and/or processes have not and do not infringe, contribute to the infringement of, and/or induce the infringement of any asserted claim of the '798 patent and/or each asserted claim of the '798 patent is invalid for failure to meet one or more of the statutory and decisional requirements for patentability, including, but not limited to, 35 U.S.C. §§ 101-103 and/or 112.

SEVENTH AFFIRMATIVE DEFENSE**Estoppel**

51. Freescale's Counterclaims and each and every purported cause of action therein, in whole or in part, are barred by the equitable doctrine of estoppel.

EIGHTH AFFIRMATIVE DEFENSE

Laches

52. Freescale's Counterclaims and each and every purported cause of action therein, in whole or in part, are subject to the equitable doctrine of laches.

NINTH AFFIRMATIVE DEFENSE

Statute of Limitations

53. The statements and conduct of Maxim alleged to give rise to Freescale's Counterclaims and each and every purported cause of action therein, in whole or in part, are subject to the applicable six-year statute of limitations.

TENTH AFFIRMATIVE DEFENSE

Mitigation

54. Freescale had a duty to mitigate its alleged damages and failed to do so. Its damages are therefore either barred or reduced.

ELEVENTH AFFIRMATIVE DEFENSE

Failure to Mark

55. On information and belief, Freescale's claims of damages are barred, in whole or in part, due to its failure to mark under 35 U.S.C. § 287.

TWELFTH AFFIRMATIVE DEFENSE

Limitation on Damages

56. On information and belief, Freescale's claims of damages are limited, in whole or in part, under 35 U.S.C. § 286.

THIRTEENTH AFFIRMATIVE DEFENSE

Other Defenses

57. Maxim intends to rely on any other defenses that may be available by law, or pursuant to statute, of which Maxim becomes aware as a result of discovery or otherwise

1 during the course of this matter, and hereby reserves the right to amend this Reply to assert
2 such defenses.

3 **PRAYER FOR RELIEF**

4 WHEREFORE, Maxim prays for judgment as follows:

- 5 (a) For judgment that Freescale's Counterclaims be dismissed with
6 prejudice and Freescale's requests for relief be denied in their entirety;
7 (b) For the Court to grant to Maxim the relief requested in Maxim's
8 Declaratory Judgment Complaint;
9 (c) For the Court to declare this to be an exceptional case under 35 U.S.C.
10 § 285 and to award Maxim its attorneys' fees incurred in connection
11 with Freescale's Counterclaims;
12 (d) For an award to Maxim of all costs and expenses of this action; and
13 (e) For such additional relief as this Court may deem just and proper.

14
15 May 20, 2008

Respectfully submitted,

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24 MAXIM INTEGRATED PRODUCTS, INC.
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Certificate of Service

I hereby certify that all counsel of record, who are deemed to have consented to electronic service are being served this 20th day of May 2008, with a copy of this document via the Court's CM/ECF system. Any other counsel of record will be served by electronic mail on this same date.

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